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IN THE

Supreme Court of the United States

October Term, 1974

No. 74-1644

JOHN C. SHEEHAN,

Petitioner,

v.

FRANK P. DOYLE, *et al.*,

Respondents.

PETITIONER'S REPLY BRIEF IN SUPPORT OF HIS PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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Petitioner submits this Reply Brief to counter arguments first raised in Respondents' Brief in Opposition.

I

The fact that respondents are non-resident aliens does not distinguish the present case from the cases cited by petitioner showing a conflict between the Circuit Courts of Appeals.

Respondents contend that there is no conflict between the Courts of Appeals because the cases cited by Petitioner establishing such conflict are distinguishable because they did not deal with discovery from a *non-resident alien* (respondents are such) under Rule 34 of the Federal Rules of Civil Procedure. We submit that this contention is misleading.

Respondents' contention ignores the clear language of the decision of the Court below which made its ruling as follows:

> "After considering arguments for and against compelling discovery from the nonresident aliens, the district court ordered Doyle and BRL [Beecham] to produce those documents sought that were not priviledged. From this order Doyle now appeals. Doyle objects to the order on the grounds of lack of personal jurisdiction and proper venue, as he is a non-resident alien with no ties to Massachusetts. We do not reach these arguments because we hold that section 24 does not confer jurisdiction upon the district court, acting on its own, to grant Rule 34 discovery directly, *whether against a non-resident alien or a resident citizen.*" [emphasis supplied] Appendix A, page 5a.

Thus, the court below held it was immaterial to its decision that Doyle was a non-resident alien. It follows that the distinction asserted by Respondents is without substantive legal effect and that there is, in fact, a conflict among the Circuit Courts of Appeals for the reasons stated in the Petition.

A recent decision by the Second Circuit Court of Appeals indicates that the conflict will not be resolved in the near future without the intervention of this Court. On July 16, 1975, in the case of *Shattuck* v. *Hoegl,* —— F.2d ——, the Second Circuit ruled on the appealability of discovery orders issued in ancillary proceedings under authority of 35 U.S.C. § 24 in connection with a Patent Office interference. Although the Second Circuit did not comment on the recent limiting construction of 35 U.S.C. § 24 by the First and Third Circuit Courts of Appeals, its ruling

clearly indicates that the jurisdiction of the district court is not to be limited to issuing subpoenas in support of discovery which has been authorized by the Patent Office. Quite to the contrary, the Patent Office Board of Patent Interferences had refused to grant the discovery which the district court subsequently ordered. Although the specific issue resolved by the Second Circuit is only peripherally related to that which has been raised by Petitioner, the case is positive evidence that a conflict does exist between the circuits on the construction of 35 U.S.C. § 24.

II

The present fact situation is not "unique", but has been considered by the Third Circuit Court of Appeals and is likely to arise again.

In urging that this case does not warrant certiorari Respondents state on page 6 of the Brief in Opposition:

> "The facts of the present case are unique. There is no decision *prevailing* in any of the Circuits which provides that a nonresident alien can be compelled to produce documents and materials under Rule 34 of the Federal Rules of Civil Procedure in a jurisdiction in which he cannot be subpoenaed, in an ancillary action under 35 U.S.C. §24 for the sole purpose of taking discovery for use in a Patent Office interference. It is, therefore, submitted that the decision of the First Circuit Court of Appeals was correct when it refused to permit Petitioner to take such discovery from Respondents who are nonresident aliens residing in Great Britain." [emphasis supplied]

and further on page 11:

> "There is no conflict among the Courts of Appeal because *no* Court of Appeals has previously come to a

> contrary decision on a similar fact situation. The present case is unique in that it is the only case involving an attempt by a United States citizen to take discovery from nonresident aliens under Rule 34 of the Federal Rules of Civil Procedure." [emphasis supplied]

The first statement is misleading and the second statement is simply not true.

Respondents ignore and fail to inform this Court of the decision of the Third Circuit Court of Appeals in *Vogel* v. *Jones,* 443 F.2d 257 (1971) in which a fact situation indistinguishable from the present one was considered and document discovery was ordered.

Indeed, *Vogel* v. *Jones,* which reflected the then prevailing view that 35 U.S.C. § 24 was to be construed broadly, was relied upon by Judge Garrity in his opinion in the U.S. District Court below granting Sheehan's requested discovery, in which opinion (dated August 9, 1974) he stated (Appendix C, page 10a):

> "In our view these proceedings are not materially different from those in Vogel v. Jones 3 Cir. 1971, 443 F.2d 257."

There is no material difference between the situation presented to the District Court below and that of *Vogel* v. *Jones.* In the *Vogel* case, Vogel (read Sheehan), a party to a patent interference proceeding, sought to obtain production of *documents only* under Rule 34 from the other party to the interference Jones (read Doyle et al.) and ICI, Ltd. (read Beecham Research Laboratories, Ltd.), the

corporate employer-assignee of the Jones (Doyle et al.) patent application. Vogel was a resident of Minnesota (Sheehan is a resident of Massachusetts). Both Jones and ICI were aliens residing in Great Britain (Doyle et al. and Beecham are aliens residing in Great Britain). The Vogel discovery was commenced in the District Court of the District of New Jersey under authority of 35 U.S.C. § 24 by filing a "Notice of Ancillary Proceedings for Discovery under 35 U.S.C. § 24" and a request for production of documents by Jones and ICI and serving the Notice and request on the parties and their counsel (Sheehan commenced his discovery under §24 in the District Court for the District of Massachusetts by filing a similar notice and request and serving them in the same manner).

The District Court of New Jersey dismissed the discovery proceedings for lack of personal jurisdiction over Jones and ICI. The Third Circuit reversed. In response to the arguments by Jones and ICI that the court lacked *in personam* jurisdiction, the Third Circuit held that personal jurisdiction attached when the alien parties filed the interfering patent application in the Patent Office. Thus, when the ancillary discovery provisions of Section 24 are taken with 28 U.S.C. § 1391(d), which provides that an "alien may be sued in any district", production of documents can be ordered by any federal district court upon proper motion by the opposing party. Having found that the federal district court in New Jersey had sufficient personal jurisdiction over the parties to compel production of documents, the Third Circuit then determined that requirements of due process had also been met by the service of the notice upon all the parties and their counsel.

The later decision in 1975 of the Third Circuit Court of Appeals in *Frillette et al.* v. *Kimberlin et al.*, 508 F.2d 205 (*en banc*), reversing its prior decisions giving a broad construction of 35 U.S.C. § 24 and adopting a narrow construction, in our view did not overrule *Vogel* v. *Jones* on the basis of the involvement of a non-resident alien, but only insofar as the discovery sought did not meet the new narrow construction of having been authorized by the Patent Office.

If this Court were to grant the Petition and to rule that the First Circuit Court had erred in its construction of 35 U.S.C. § 24, we believe that such ruling would likewise apply to the Third Circuit's decision in *Frillette*, and would have the effect of reinstating the earlier decisions of the Third Circuit, including *Vogel* v. *Jones*. While not controlling on other circuits, these decisions would undoubtedly be of great influence in deciding like or similar questions.

Thus, the present fact situation is not "unique" as alleged by Respondents in their Brief in Opposition, but is indistinguishable from that presented in *Vogel*. Moreover, in view of the large number of patent applications filed in the United States Patent and Trademark Office by, or on behalf of, non-resident aliens it cannot be denied that similar patent interference-related discovery issues are likely to be raised.

Conclusion

For the above reasons and those previously presented by petitioner we respectfully request that the petition be granted.

Respectfully submitted,

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